REMARKS

This Amendment is submitted in response to the Office Action mailed on January 14, 2008. Claims 1 - 15 are pending, and all stand rejected at present. Claim 14 has been cancelled, and claims 16 - 21 are added. No fee is due.

RESPONSE TO 103 - REJECTIONS

Claims 1 - 10, 13, and 14 were rejected as obvious, based on Shannon and Spero.

Shannon Reference

Shannon allows a customer to undertake a transaction at a POS, Point of Sale terminal. He gives the customer the option of obtaining a printed receipt. (Paragraph 19.)

Irrespective of whether a printed receipt is generated, the POS electronically transmits data contained in the receipt to a central archive, where it is kept for a time period. (Paragraphs 27, 28.)

If the customer wishes to obtain a copy of the receipt, the customer contacts the archive by computer, and makes a request. The receipt is then sent to the customer electronically. If a printer is present at the site where the customer is located, that electronic receipt can be printed. (Paragraphs 32, 33.)

Several significant features of Shannon are the following.

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One, the customer must make a **request** to obtain a copy of the receipt. The copies are not sent to the customer automatically.

Two, the POS is equipped with a printer, so that, if the customer wished, he could obtain a paper receipt.

Three, the data transmitted by the POS to the archive is text-type data, and limited in amount. Shannon touts this as a benefit, compared with a prior-art approach wherein a paper receipt is scanned at a POS, and then transmitted as a bitmap. He asserts that the bitmap requires about 30 times the amount of data as the text data: 10,000 bytes for the former, vs 300 bytes for the latter. (Paragraphs 45 and 46.)

When a copy of the receipt is to be created, the text-type data is recovered, and additional information may be added to the receipt. (Paragraphs 29 and 38.)

Spero Reference

Spero shows a system wherein a user collects his paper receipts for transactions, scans them into digitized form, and stores them. The digitized receipts can undergo character recognition, to extract data, and then be inserted into "expense reports." (Column 4, lines 8 and 60 - 62; column 2, line 44; column 6, lines 11 - 13.) Each receipt can be overlaid onto the expense report, next to the line in the report corresponding to the receipt. (Column 4, lines 22 - 24; column 6, lines 52 - 55.)

Spero's Figure 6 shows an "expense report," with a copy of a receipt overlaid onto the report.

Applicant points out that this "expense report" is generated by Spero's user. The user scans the receipts, classifies the receipts which he scans, adds comments if desired, and organizes them into the report. (Column 4, lines 9 - 24.)

Application of References to Claims

Claim 1

Original claim 1(c) recited: "including the receipt image in a customer bank or account statement." The Office Action cites Spero's Figure 6 as showing this recitation.

POINT 1

Even if the references are combined, claim 1(c) is not attained.

Spero's Figure 6 does not show a "customer bank or account statement" as claimed. Applicant points out that, under the rules of English grammar, claim 1(c) is read as "customer bank statement or customer account statement."

The expense report in Spero's Figure 6 was generated by the customer, and is a list of expenses. It is not the type of "statement" recited in claim 1(c).

MPEP § 2143.03 states:

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> To establish <u>prima facie</u> obviousness . . . **all
> the claim limitations** must be taught or
> suggested by the prior art.

It could be argued that Spero's expense report in his Figure 6 corresponds to the claimed "account statement" on the grounds that Spero's report "accounts" for amounts shown on his receipts, and thus acts as a "statement."

Applicant submits that such an interpretation is unreasonable, at least for the reasons that

> 1)   the claim term "account statement" is a
> term-of-art, and the interpretation splits the
> term into its individual components, and
> interprets the components separately,
>
> 2)   the claim phrase is "customer bank or
> account statement," which clearly implies that
> the "statement" is received by the user from
> somebody else, and
>
> 3)   the claim phrase refers to a "statement,"
> while no "statement" is present in Spero's
> Figure 6.

Nevertheless, in the interest of furtherance of prosecution, the phrase "sent to the user" has been added, as well as the word "periodic."

POINT 2

The claim recites "a method of providing a receipt to a user
. . . ."

This language cannot apply to Spero, because Spero's already
has the receipts in his possession.

Thus, the "receipt" in Spero's Figure 6 is not "provided" to
the "user."

Even if the references are combined, the claim is not
attained.

POINT 3

Under the claim, the "receipt" is "provided" to the "user"
through the recited steps. Even if those steps are found in the
references, they do not result in "providing" the claimed "receipt"
to the user, in the manner claimed. As just explained, the user
in Spero already has the receipts.

POINT 4

Even if the references are combined, the claim is not
attained.

Spero's digitized receipt-image does not correspond to the
claim language. The claim states that

-- a "host terminal" receives "receipt
information from a . . . terminal;"

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-- the "receipt information" is used to create an "image of a receipt;" and

-- the "receipt image" is included in an "account statement."

Spero's Figure 6 is cited to show the very last element above. However, Spero's Figure 6 is being interpreted in isolation. His Figure 6 does not show the last element above, when read in the context of the claim.

The simple reason is that the "receipt image" in Spero's Figure 6 is not created from the claimed "receipt information." Under the claim, that "receipt information" was transmitted from a "terminal" to the "host terminal."

Stated more simply, the "receipt image" of the claim was generated from electronic data which originated at a POS.

Spero's receipt in his Figure 6 does not possess those properties.

Therefore, even if the references are combined, the claim language is not attained.

Consequently, the items in Spero's Figure 6 do not correspond to "**THE** receipt image" of claim 1(c). "**THE**" receipt image refers to the receipt image previously recited in the claim. Spero shows no such "image."

POINT 5

Point 4 can be stated another way.

Assume that you find claim 1(a) and (b) in Shannon. Then you add Spero's Figure 6, to attempt to find claim 1(c).

The copy of the receipt in Spero's Figure 6 does not correspond to **"THE** receipt image" of claim 1(c). Spero's receipt in his Figure 6 does not possess the properties recited in claim 1(c). Spero's receipt image was generated by Spero's user, and not generated as recited in claim 1(a) and (b).

Thus, the combination of references produces **something other than** claim 1. In this example, the combination produces

    -- Claims 1(a) and (b), and

    -- A digital image of a receipt, laid atop an

    "expense report," wherein both the image and

    the report were generated by Spero's user (ie,

    Spero's Figure 6).

That does not show claim 1.

It shows Spero's Figure 6 combined with Shannon. Claim 1 does not recite that.

POINT 6

No expectation of success has been shown, indicating that the combination of references actually works.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

. . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The Office Action has not explained how Spero's Figure 6 is obtained from the processes in Shannon, which supposedly show claim 1(a) and (b).

POINT 7

No valid teaching has been given for combining the references. The rationale is that "Motivation . . . exists because providing a receipt image in an account statement provides a convenient method of viewing and maintaining receipt records."

However, several problems exist in this rationale.

PROBLEM 1

This motivation is found in Applicant's disclosure, and is thus based on hindsight. (Page 2, lines 18 - 20, for example.)

MPEP § 707.07 states:

> . . . it must be recognized that any judgment
> on obviousness is in a sense necessarily a
> reconstruction based upon hindsight reasoning.
>
> But so long as it takes into account only
> knowledge which was within the level of
> ordinary skill at the time the claimed
> invention was made,
>
> and
>
> **does not include knowledge gleaned only from
> the applicant's disclosure, such a
> reconstruction is proper.**

In this case, the rationale is clearly based on Applicant's

Specification, and the rationale has not been shown in the prior

art.

Hindsight is being used.

PROBLEM 2

The rationale merely points to a supposed characteristic of

the references, but after combining them. At least two problems

exist in such a rationale.

One problem is that no showing has been made that a person

skilled-in-the-art is seeking this characteristic. MPEP §

706.02(j) states:

> Contents of a 35 U.S.C. 103 Rejection
>
> . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

This MPEP section requires that the PTO show the desirability of the improved verification, and show that in the prior art. That has not been done.

A second problem is that the Office Action merely points to a supposed characteristic of the references, but **after** combining them. That is not a teaching for combining them in the first place, and that is not a teaching found in the prior art.

PROBLEM 3

Every combination of references will have some characteristics or other. The mere presence of a characteristic in the combination

is not a teaching for making the combination.

Simple logic dictates this conclusion. If the mere presence of a characteristic acts as a teaching, then **every combination** would be obvious, because every combination has characteristics. The law of obviousness would be rendered moot.

POINT 8

Spero is contrary to Shannon, so that the two references cannot be combined. As explained above, Shannon states that transmission of a bitmap of an image is not preferred, compared with transmission of text characters.

In contrast, Spero states that bitmaps should be made, and recorded.

The references are contrary.

POINT 9

Spero and Shannon are contrary, in the sense that they represent "apples and oranges," which cannot be combined.

In Spero, the customer is in possession of the paper receipts. (If he were not in possession, it would be impossible to implement Spero's system.) Spero's customer then creates digital images of the receipts.

In Shannon, a POS creates data file of the essential information in a receipt. The data file is not a digital image,

and Shannon expressly states that this is desirable, to reduce the amount of data stored. (Paragraphs 45 and 46.) Shannon delivers an electronic copy of the receipt to the customer, if the customer requests.

Applicant submits that no combination of the two references leads to claim 1, or at least the undersigned attorney can see no such combination.

Conclusion as to Claim 1

Applicant submits that the discussion above shows that the combined references do not show claim 1.

Claims 2 - 10, 13, and 14

The discussion above applies to claims 2 - 10, and 13. Claim 14 has been cancelled.

Response to 102 - Rejections

Claims 11, 12, and 15 were rejected on grounds of anticipation, based on Shannon.

Claim 15

POINT 1

Applicant points out that the three "means" of claim 15 are **contained in the ATM.**

In Shannon, text contained in a receipt is transmitted by the POS to an archive. (Paragraphs 28 and 29.) The customer then retrieves a receipt based on that text from the archive. (Paragraph 30.)

Thus, the POS in Shannon does not contain the "means" of claim 15. Any such "means" are found **outside the POS**.

POINT 2

Section 112 states:

> . . . [a means-plus-function] claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The Office Action has not shown that Shannon shows the "corresponding" subject matter of Applicant's Specification, nor "equivalents thereof" in Shannon.

Claims 11 and 12

Claims 11 and 12 state that the ATM transmits a "template." Thus, the ATM must contain the "template."

Paragraphs 6 and 7 of Shannon are cited to show this. However, the word "template" cannot be found in those paragraphs, nor a statement that an ATM contains the template.

Shannon's claims 1, 3, 4, 20, and 21 are also cited to show

this. However, no discussion of a "template" is found in those claims.

Applicant thus requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify the claimed "template" in Shannon.

Claims 11 and 15

Claims 11 and 15 state that an ATM performs the claimed operations, or contains the claimed elements.

The Office Action relies on a POS in Shannon to show the claims.

The Office Action has not explained how Shannon's POS qualifies as an ATM.

Added Claims

Support for added claims 16 - 21 can be found in the Specification at the following locations:

-- page 4, lines 24 - 26;

-- page 6, lines 3 - 6; and

-- the absence of a printer in ATM 10 in

Figure 2.

The added claims state, speaking generally, that the ATM or terminal lacks a printer, or does not print receipts. That is contrary to both Shannon and Spero.

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

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